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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,280	09/21/2000	Kyoung Ro Yoon	24286/81251	8463

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SIDLEY AUSTIN BROWN & WOOD LLP  
555 CALIFORNIA STREET  
SUITE 2000  
SAN FRANCISCO, CA 94104-1715

EXAMINER
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DUONG, OANH L

ART UNIT	PAPER NUMBER
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2155

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/666,280	<b>Applicant(s)</b> YOON ET AL.	
	<b>Examiner</b> Oanh Duong	<b>Art Unit</b> 2155	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/02/06, &amp; 01/08/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 51-91 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 51, 71, and 81 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claims 51, 71, and 81 appear to be an abstract idea rather than a practical application of the idea. Claims 51, 71, and 81 does not require any physical transformation and the invention as claimed does not produce a useful concrete and tangible result. Specifically, the claimed invention does not appear to produce a useful, concrete and tangible result because merely providing a user description is nothing more than a thought or computation within a processor. It fails to use or make available for use the result of the user description to enable its functionality and usefulness to be realized. Additionally, the asserted practical application in Applicant's specification is "providing multi-media information by using a multiple hierarchical structure in which information is provided to a user according to a user preference" as defined I page 5 lines 21-23). The practical application is not explicitly recited in the claim nor does it flow inherently therefrom. Therefore, claim 1 appears non-statutory. see M.P.E.P 2601:

"A. Identify and Understand Any >Utility and/or< Practical Application Asserted for the

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**Invention**

The claimed invention as a whole must >be useful and< accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at \*1373-74<, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 \*\*> (1966); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993))."

5. Claim 81 is not limited to tangible embodiments. The claim recited "A Computer program product..." is nonstatutory. Since claim 81 recited "A computer program product." is just limited to a functional descriptive materials" consists of computer program per se, instead of being defined as including tangible embodiments (i.e., a computer readable storage medium such as memory device, storage medium, etc.). As such, the claim is not limited to statutory subject matter and is therefore nonstatutory.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 51-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (hereafter, Herz), US 5,758,257, in view of Kothuri et al. (hereafter, Kothuri), US 6,470,344 B1.

Regarding claim 51, Herz teaches method for processing user preferences related to multimedia content consumption (see abstract), the method comprising:

providing a user description including a user preference description that has a hierarchical structure to describe preferences for filtering and searching (col. 29 lines 31-51 and col. 50 line 65-col. 51 line 55), the hierarchical structure including a first parent preference element and a second parent preference element at the same level of the hierarchical structure, the first parent preference element having one or more first child preference elements (col. 17 lines 45-65), each of the parent and child preference elements including at least one multimedia preference description to identify preferred multimedia content (col. 17 lines 28-65).

Herz does not explicitly teach a first parent preference element in the hierarchical structure includes a first preference condition that specifies a place to which the first parent and first child preference elements apply.

Kothuri teaches method for buffering a hierarchical index of multi-dimensional data for query/search operation (see abstract). Kothuri teaches a preference condition that specifies a place to which preference elements apply (col.13 lines 14-58: Kothuri discloses data is retrieved based on one or more hierarchically structured data attributes/conditions which include a region/place).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a hierarchical structure data attribute including a region/place as taught by Kothuri into an element in a hierarchical structure in Herz. One would be motivated to do so to allow data to be retrieved based on a particular

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condition/attribute, thereby providing more efficient use of the data (Kothuri, col. 7 line 14).

Regarding claim 52, Herz teaches the method of claim 51, wherein each of the first parent and first child preference elements includes a respective preference value to characterize relative importance of the corresponding multimedia preference description (Herz, col. 49 line 62-col. 50 line 15).

Regarding claim 53, Herz teaches the method of claim 51, wherein providing the user description includes receiving user input defining at least a portion of the multimedia preference description in one of the first parent and first child preference elements (col. 4 lines 41-46).

Regarding claim 54, Herz teaches the method of claim 51, wherein the user description includes a usage history describing events of consuming multimedia content (col. 29 lines 52-67).

Regarding claim 55, Herz teaches the method of claim 51, wherein filtering multimedia content includes recommending multimedia content (col. 23 lines 1-5).

Regarding claim 56, Herz teaches the method of claim 51, wherein the multimedia preference description in one of the parent and child preference elements specifies a multimedia genre (col. 22 line 47-col. 23 line 1).

Regarding claim 57, Herz teaches the method of claim 51, wherein the multimedia preference description in one of the first parent and first child preference elements specifies an actor or a director (col. 11 lines 45-58).

Regarding claim 58, Herz teaches the method of claim 51, wherein one of the first child preference elements of the first parent preference element includes a further preference condition (col. 5 lines 23-28).

Regarding claim 59, Herz teaches the method of claim 51, further comprising: updating the user description (col. 42 lines 12-24).

Regarding claim 60, Herz teaches the method of claim 51, further comprising: storing the user description (col. 45 lines 34-55).

Regarding claim 61, Herz teaches the method of claim 51, wherein the user description includes a user identifier specifying a name for at least one user, and the first and second parent preference elements apply for the same at least one user (col. 17 lines 45-65 and col. 26 lines 22-50).

Regarding claims 62-70, those claims represents a method for processing user preferences related to multimedia content consumption, taught by the prior art as identified on claim 51-61, discussed above, same rationale of rejection is applicable.

Regarding claims 71-76, those claims represents a system for processing user preferences related to multimedia content consumption, taught by the prior art as identified on claims 51-56, discussed above, same rationale of rejection is applicable

Regarding claims 77-80, those claims represents system for processing user preferences related to multimedia content consumption, taught by the prior art as identified on claims 51-56, discussed above, same rationale of rejection is applicable

Regarding claims 81-85, those claims represents a computer program product for processing user preferences related to multimedia content consumption, taught by the prior art as identified on claims 51-61, discussed above, the same rationale of rejection is applicable.

Regarding claims 86-91, Herz-Kothuri teaches a second preference element includes a second preference condition that specifies a second place to which the second parent preference element applies (Kothuri, col. 13 lines 36-58).



***Response to Arguments***

8. Applicant's arguments filed 01/18/2007 have been fully considered but they are not persuasive.

In the remark, applicant argued in substances that

(A) Neither Herz nor Kothuri discloses or suggests that the first parent preference in the hierarchical structure including a first preference condition that specifies a place to which the multimedia preference descriptions in the first parent and first child preference element apply.

As to point (A), Examiner asserts that the combination of teachings of Herz and Kothuri does teach the first parent preference in the hierarchical structure including a first preference condition that specifies a place to which the multimedia preference descriptions in the first parent and first child preference elements apply.

For example, Herz teaches a hierarchical structure including a condition (i.e., mood) that the multimedia preference descriptions in parent and child elements apply (col. 17 lines 28-65). Herz does not teach a condition that specified a place. However, Kothuri teaches a condition that specified a place (col.13 lines 14-58: Kothuri discloses hierarchically structured data attributes/conditions which include a region/place). Therefore the combination of teachings of Herz and Kothuri does teach the first parent preference in the hierarchical structure including a first preference condition that specifies a place to which the multimedia preference descriptions in the first parent and first child preference element apply.

(B) there is no motivation to combine and modify Herz and Kothuri.


In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Herz teaches a hierarchical structure including a condition that the multimedia preference descriptions in parent and child elements apply (col. 17 lines 28-65). Kothuri teaches a condition that specified a place (col. 17 lines 28-65). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the hierarchical structure of Herz to include a condition that specified a place as taught by Kothuri. One would be motivated to do so to allow data to be retrieved based on a particular condition (or mood or attribute), thereby providing more efficient use of the data (Kothuri, col. 7 line 14).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh Duong whose telephone number is (571) 272-3983. The examiner can normally be reached on Monday- Friday, 9:30PM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Oanh Duong  
April 2, 2007